

In re Application of: Glorioso et al.
Application No. 09/506,301

- Group I: claims 1-16, classified in class 435, subclass 235.1,
Group II: *in vitro* embodiments of claims 17-19, classified in class
435, subclass 455, and
Group III: *in vivo* embodiments of claims 17-20, classified in class 514,
subclass 44.

Discussion of Restriction Requirement

In response to the restriction requirement, applicants elect, with traverse, the claims of Group I (claims 1-16) for further prosecution. Applicants urge the requirement to be withdrawn, however, because the requirement for restriction in this instance is not proper. In this regard, the MPEP requires two separate criteria to be met to support a proper requirement for restriction between groups of claims:

- (i) the inventions must be independent or distinct as claimed,
- AND
- (ii) there must be a serious burden on the Office if restriction is not required.

MPEP § 803. In the case at hand, the Office has failed to satisfy these criteria.

The sole basis the Office sites for requiring restriction is that the claims are separately classified and, therefore, allegedly distinct. This assertion, however, cannot alone support a restriction requirement. Indeed, the MPEP provides that “[I]f the search and examination of an entire application can be made without serious burden, the Office must examine it on the merits, even though it includes claims to distinct or independent inventions (MPEP § 803, emphasis added).” In this case, the Office has not asserted, let alone demonstrated, that it would encounter a “serious burden” in the absence of claim restriction. By failing to do so, the Office has not made out a *prima facie* case for the restriction requirement.

Even if the claims are drawn to distinct inventions, they must be searched and examined together. For example, as they are drafted, claims 17-19 can be practiced on cells *in vitro*, *in vivo*, *in situ*, *ex vivo*, or in any other desired location¹, and a proper search of these claims must include all appropriate classes and subclasses (which the Office Action identifies as including at least class 435, subclass 455 and class 514, subclass 44). Moreover, the claims of Groups II and III ultimately depend from claim 1, which is in

¹ The distinction between *in vivo* and *in vitro* applications of claims 17-19 for segregating the Groups II and III claims is arbitrary in this instance because the distinction is not based on any claim language.

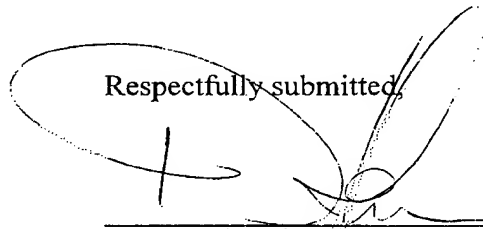
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Group I. As such, a search of the subject matter of Groups II and III must include the subject matter of Group I. Thus, all three Groups of claims should be searched together.

Conclusion

The application is considered in good and proper form for allowance, and the Examiner is respectfully requested to pass this application to issue. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,



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